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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,095	02/08/2001	Jean-Louis Gueret	20982-13	1674
22852	7590	07/20/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			GHALI, ISIS A D	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,095

Applicant(s)

GUERET, JEAN-LOUIS

Examiner

Isis Ghali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-30 and 35-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-30 and 35-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/29/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The receipt is acknowledged of applicant's request for extension of time, request for REC, amendment, and IDS, all filed 04/29/2005.

Claims 2-4, 31-34 have been canceled, claims 56-64 have been added.

Claims 1, 5-30, 35-64 are pending and included in the prosecution.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/29/2005 has been entered.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 5-30, 35-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-68 of U.S. Patent No. 6,723,306. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed composite structure has the same structure of the article of the issued patent, i.e., an adhesive matrix between two non-adherent layers, which are bonded to the adhesive matrix. Further, the tanning agent claimed by the patent anticipates the instant active agent.

4. Claims 1, 5-30, 35-64 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-55 of copending Application No. 10/7107,410. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed composite structure has the same structure as the treatment device of the copending application, i.e. two non-adhesive layers and active agent contained in an adhesive matrix between the two non-adhesive layers. Accordingly, the present claims anticipate the co-pending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 9, 11, 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 9 and 11, the expressions "freeze-dried substances", "wetting agents", "healing agents", "vascular protectors" and "skin conditions" do not set forth the metes and bounds of the claims. Recourse to the specification does not define the expressions.

Regarding claim 14, the recitation of "vinyl", which is a chemical group, as an adhesive does not set forth the metes and bounds of the claim. Recourse to the specification disclosed adhesives based on vinyl.

Regarding claim 11, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. The claims are rendered indefinite by raising a question or doubt introduced by a subject of more than one interpretation, and one interpretation would render the claim unpatentable over the prior art. In the present instance, wide

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ranges are "anti-inflammatory agents" and "keratolytic agents" and the narrow range is "salicylic acid".

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 6-11, 14, 16, 18, 25-30, 39-41, 43, 45-48, 51-59 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5,965,276 ('276).

US '276 disclose articles that are made of multiple layers or membranes wherein the article comprises two permeable or semi permeable outer layer, and an intermediate layer (fig. 2; col. 7, lines 18-20, lines 38-52), and construed in a manner that is triggered to release the agent from inside (col. 9, lines 20-24). The intermediate layer is a reservoir layers for active substances such as abrasives which reads on the depigmenting agents and keratolytic agents, and antiseptic and sterilizing agents which read on healing agents, or cleansing agent (col. 3, lines 48-52). The intermediate layer is sticky and made of adhesive and film forming material that reads on the instant adhesive matrix (col.3, lines 53-55; col.5, lines 3-29); and further the semi permeable layers permit migration of active substances from inside (col.2, lines 50-54). US '276

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discloses that the outer layers are formed from polymer or latex materials (col. 4).

Further, US '276 discloses that the adhesive inner layer may be made from known adhesive such as polyacrylic polymers and cellulose derivatives (col. 5, line 61 through col. 6, line 9). US '276 further discloses addition of other agents such as powders of calcium carbonate, cornstarch, etc., that read on instant inert compounds and moisture absorbing substances (col. 11, lines 55-68), that further allow for addition of a variety of active agents such as softening agents, cleansing agents, abrasives, etc (col. 12, lines 41-68). The article further comprising impermeable layer and two active agent layers that are different (figure 4). The reference disclosed method of making the article comprising depositing the layers on each other (col.4, lines 26-31).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 5, 15, 17, 19-24, 35-38, 42, 49, 50, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over US '276 in view of WO 98/18441 ('441).

The teachings of US '276 are discussed above, however, US '276 does not teach the water as a solvent to deliver the active agent; does not teach the outer layers made of non-woven material that have different properties; does not teach multiple layers

having the same active agent; amount of moisture absorbing agents; or using the article for treating hair.

The amounts and the multiplication of layers do not impart patentability to the claims, absent evidence to the contrary.

WO '441 teaches article comprising two layers made of non-woven fabric of different texture and porosity with more than active agents enclosed in between that are released upon wetting with water. The article used for application of active agent to the skin and hair (abstract; page 6, second full paragraph; page 8; first full paragraph; page 9, first full paragraph; pages 21 and 22; page 26, second full paragraph; page 27, forth and fifth paragraphs; claims). The article is inexpensive, highly convenient and optimizes the delivery and deposition of the active agents (page 2, third and forth full paragraphs).

Therefore, it would have been obvious to one having ordinary skill in the art the time of the invention to provide the article disclosed by US '276 that comprises two outer layers and one active agent adhesive layer in between and use the non-woven materials disclosed by WO '441 to form the outer layers that have different textures, motivated by the teaching of WO 441 that article with that structure is inexpensive, highly convenient and optimizes the delivery and deposition of the active agents; with reasonable expectation of having an inexpensive convenient article having two outer layers of non woven fabric having different properties and an adhesive intermediate layer containing active agent to be optimally delivered to skin or hair upon wetting with water.

11. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over US '276 in view of US 6,338,839 ('839).

The teachings of US '276 are discussed above, however, the reference does not teach the inert compound to be polyamide.

US '839 teaches topical cosmetic composition that has transfer resistance from the skin to the surfaces it comes in contact with (abstract; col.2, lines 17-20, 30-35). The composition comprises Orgasol which is polyamide powder (col.5, lines 4, 49-58).

Therefore, it would have been obvious to one having ordinary skill in the art the time of the invention to provide the article disclosed by US '276 that comprises two outer layers and one active agent adhesive layer in between, and add polyamide powder to the active agent containing layer as disclosed by US '839, motivated by the teaching of US '839 that cosmetic comprising this powder has transfer resistance from the skin to the surfaces it comes in contact with, with reasonable expectation of having an article comprising two outer layers and middle adhesive layer that delivers a cosmetic that has transfer resistance on application to skin.

12. Claims 12, 13, 61-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over US '276 in view of JP 04108710 ('710).

The teachings of US '276 are discussed above, however US '276 does not teach the magnetizable particles.

JP '710 teaches cosmetic in adhesive matrix comprising magnetizable particles that are capable of promoting of blood flow to the skin without causing inflammation to the skin (abstract).

Therefore, it would have been obvious to one having ordinary skill in the art the time of the invention to provide the article disclosed by US '276 that comprises two outer layers and one active agent adhesive layer in between, and add magnetizable particles to the active agent containing layer as disclosed by JP '710, motivated by the teaching of JP '710 that the magnetizable particles are capable of promoting the blood flow to the skin without causing its inflammation, with reasonable expectation of having an article comprising two outer layers and middle adhesive layer comprising magnetizable particles that promotes the blood flow to the skin without causing its inflammation.

Response to Arguments

13. Applicant's arguments with respect to claims 1, 5-30, 35-64 have been considered but are moot in view of the new ground(s) of rejection.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Isis Ghali
Examiner
Art Unit 1615

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ISIS GHALI
PATENT EXAMINER